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APR 02 2004

OFFICE OF PETITIONS

In re Application of :
Ashkenazi, Fong, Goodard, Gurney, : DECISION REFUSING STATUS
Napler, Tumas, Van Lookeren, and : UNDER 37 CFR 1.47(a)
Wood :
Application No. 10/633,008 :
Filed: 31 July, 2003 :
Atty Docket No. 39766-0100P1 :

This is in response to the petition filed under 37 CFR 1.47(a) on 31 July, 2003.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 31 July, 2003, with a petition under 37 CFR 1.47(a) identifying Application No. 10/265,542 (of which the present application is a continuation-in-part (CIP)), and a copy of the decision granting that petition.

Accordingly, on 21 October, 2003, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed declaration and a surcharge for its late filing. In response, on 20 February, 2004, petitioners filed a two (2) month extension of time, the late-filing surcharge, and a declaration naming Avi Ashkenazi, Sherman Fong, Audrey Goodard, Austin L. Gurney, Mary A. Napler, Daniel Tumas, Menno Van Lookeren, and William I. Wood as joint inventors, signed by all joint inventors except Tumas on behalf of themselves and joint inventor Tumas.

Petitioners state that joint inventor Tumas was sent a copy of the application identified in the petition, but has not returned an executed declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), petitioners have not provided proof that the non-signing inventor was ever sent or given a copy of *this* application as filed (specification, including claims, drawings, if any, and the declaration).¹ While the petition contains a declaration by Teri Lee that the application papers for Application No. 10/265,542 were sent to non-signing joint inventor Tumas, the present application is a CIP of the prior application, and requires a new oath or declaration. Additionally, as this application is a CIP the grant of a Rule 47 petition in the prior application has no bearing on this application. Petitioners must therefore provide evidence that the present application, No. 10/633,008 was sent or given to Tumas.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application

¹MPEP 409.03(d).

was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

The petition fee of \$130.00 has been charged to counsel's deposit account, No. 08-1641, as authorized on the fee transmittal accompanying the original application papers.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.


Douglas I. Wood
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Office of Petitions